

REMARKS

Claims 1-26 are pending and at issue in the present application.

Applicants would like to thank the examiner for the courtesies extended during the telephone interview conducted on November 3, 2003, between Examiner Paula, William E. McCracken, and Erin J. Fox (applicants' attorney and patent agent, respectively). The remarks herein are intended to summarize and amplify the matters discussed in such interview.

Applicants traverse the rejections of claims 1-26 as anticipated by Cohen et al. or as obvious over Cohen et al. and Mastie.

Claim 1, and claims 2-15 dependent directly or indirectly thereon, recite a software system for generating a second page description file from a first page description file. The software system comprises a first routine for generating a template, a second routine for extraction of data from the first page description file to generate a database for storing the extracted data and a third routine for generating a second page description file from the template and the database.

Claim 16, and claims 17-26 dependent directly or indirectly thereon, recite a method of generating a second page description file from a first page description file including the steps of generating a template, extracting data from the first page description file in an automated fashion to generate a database for storing the extracted data and generating a second page description file from the template and the database.

Cohen et al. does not teach or suggest extracting data from a first page description file to generate a database for storing the extracted data and generating a second page description file from the database and a template, as recited by the claims at issue.

In fact, Cohen et al. discloses a document generation and delivery system that stores a number of pre-defined overlays, wherein each overlay includes a plurality of data fields. A set of instructions is generated to define the location of each data field within the overlay. Input data, received in the form of character strings, identifies the overlay to be used and provides specific data for insertion into the defined data fields within the selected overlay in accordance with the associated set of instructions.

Because Cohen et al. does not disclose each of the steps recited by claims 1-26, it follows that such claims are not anticipated thereby. Further, Cohen et al., does not disclose or suggest extracting data from a first page description file to generate a database for storing the extracted data and generating a second page description file from the database and a template, or that it would be possible or even desirable to do so. See the discussion of the case law below in connection with the conclusions of Cohen et al. and Mastie. Accordingly, it follows that the claims are not obvious thereover.

Mastie does not supply the deficiencies noted with respect to Cohen et al. Mastie discloses a method and apparatus for assembling a set of input page files in the correct sequence to generate a single output file in the form of a digital book. There is no disclosure or suggestion that it would have been desirable or even possible to extract data indicative of portions of a first page description file to generate a database and employ the database and a template to generate a second page description file. Therefore, the rejection of claims 10 and 23 should be withdrawn.

Furthermore, because neither Cohen et al. nor Mastie discloses or suggests that it would have been desirable or even possible to extract data from a first page description file to generate a database for storing the extracted data and thereafter generate a second page description file from the database and a template, as specified by claims 1-26, it is evident that the claims are not obvious thereover. The prior art must disclose at least a suggestion of an incentive for the claimed combination of elements in order for a *prima facie* case of obviousness to be established. See *In re Sernaker*, 217 U.S.P.Q. 1 (Fed. Cir. 1983) and *Ex Parte Clapp*, 227 U.S.P.Q. 972, 973 (Bd. Pat. App. 1985). Accordingly, the rejection of the claims at issue should be withdrawn.

For the foregoing reasons, reconsideration and withdrawal of the rejections of the claims at issue and reconsideration thereof are respectfully requested.

Appl. No. 09/388,191
Amdt. dated November 6, 2003
Reply to O.A. of August 7, 2003

The Commissioner is hereby authorized to charge any fees, which may be required in connection with this response from Deposit Account No. 50-1903. A copy of this paper is enclosed.

Respectfully submitted,

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